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PRE-APPEAL BRIEF REQUEST FOR REVIEWDocket Number (Optional)
29250-000551/US

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

Application Number
09/878,230Filed
June 12, 2001First Named Inventor
Kenneth C. BUDKA et al.

On _____

Art Unit
2135Examiner
Ponnoreay PICH

Signature _____

Typed or printed name _____

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages of attachments are provided.

I am the

☐ applicant/inventor☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)☐ attorney or agent of record.
Registration number. _____☒ attorney or agent acting under 37 CFR 1.34.
Registration number: 37,275
SignatureThomas S. Auchterlonie / Reg. No. 37,275
Typed or printed name

703-688-8000

Telephone number

December 21, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 09/878,230
Appellant: Kenneth C. BUDKA et al.
Filing Date: June 12, 2001
Conf. No.: 2080
Group Art Unit: 2135
Examiner: Ponnoreay PICH
Title: A NETWORK FOR PROTECTING USE OF RESOURCES IN A NETWORK

Attorney Docket No.: 29250-000551/US

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Randolph Building
401 Dulany Street
Alexandria, VA 22314
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December 21, 2006

ATTACHMENT TO FORM PTO/SB/33
(DETAILS OF PRE-APPEAL BRIEF REQUEST FOR REVIEW)

Sir:

Further to the concurrent filing of the attached Notice of Appeal, the following remarks are submitted in connection with the above-identified patent application under the Pilot Program for Pre-Appeal Brief Conference (Off. Gaz. Patent & Trademark Office, Vol. 1296, No. 2, July 12, 2005).

Claims 1-8, 10-15 and 17-20 are pending. Of those, claims 1, 19 and 20 are written in independent format. All of claims 1-8, 10-15 and 17-20 are rejected.

Rejections For Which Conference Is Requested

A Pre-Appeal-Brief Conference is requested to review the rejections¹ of claims 1-8, 10-15 and 17-20. Appellant disagrees with these rejections, for the reasons given previously² and for the additional reasoning that follows.

¹ The statement of rejection spans pages 3 -8 of the Final Office (mailed August 30, 2006).

² See reply by Appellant filed June 12, 2006, pages 5-8.

ADDITIONAL TRAVERSAL REASONING, CLAIMS 1-5, 7-8, 10, 12-15, 17 AND 19-20

Beginning on page 3 of the Final Office Action, claims 1-5, 7-8, 10, 12-15, 17 and 19-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,452,925 to Sistanizadeh et al. (“the Sis ‘925 patent”) in view of U.S. Patent No. 6,891,519 to Inoue et al. (“the Inoue ‘519 patent”). Appellant traverses.

Again, Appellant is willing to acknowledge that Inoue et al. discloses a type of authentication based on a failure count accessed using an identifier. Again, however, the Inoue ‘519 patent discloses that it is the user’s authentication, *not that of the mobile station*, that is used to gain access; see column 12, line 51; column 13, lines 10-21. Again, column 2, lines 9-22, makes clear that the Inoue ‘519 patent considers mobile station authentication to be different than user authentication.

In the Rebuttal Arguments on page 2 of the Office Action, the Examiner cites the Inoue ‘519 patent at column 13, lines 10-16, which states (underlined emphasis added):

In the home agent 5 having the functional configuration of FIG. 13, the consecutive user authentication failure attempts number specified by the user (or the system manager) in advance is entered in a failed attempts register 151 corresponding to each mobile computer, and a failed attempts counter 152 corresponding to each mobile computer is initialized to 0 (step S31).

The Examiner interprets column 13, lines 10-16, as a teaching that the number of failure attempts refers to attempts by the mobile computer and not attempts by the user of the mobile computer. This interpretation might be reasonable in a vacuum. But the context of the Inoue ‘519 patent clearly contradicts this interpretation.

More specifically, the Examiner’s interpretation of column 13, lines 10-16 is contradicted by the immediately following passage, namely column 13, lines 17-22, which states (underlined emphasis added):

Then, whenever the user authentication is attempted (step S22) and the user authentication is not successful as a message indicating the user authentication failure is received from the home agent 5 (step S23 NO), the failed attempts counter 122 is incremented by one (step S24). On the other hand, when the user

authentication is successful (step S23 YES), the failed attempts counter 122 is reset to 0.

Column 13, lines 17-22 teaches “user authentication failure,” not ‘mobile computer authentication’ failure.

The Examiner’s interpretation of column 13, lines 10-16 is also contradicted by column 14, lines 15-29, which states (underlined emphasis added):

[W]hen the mobile computer is connected to the visited site network and transmits the current location registration message to the home agent, the information that cannot possible be known by anyone other than the registered legitimate user is exchanged between the mobile computer and the home agent, so that it is possible to authenticate the user who is operating the mobile computer and therefore it is possible to operate the mobile computer more safely.

Also, ... the user authentication is carried out regularly even after the mobile computer transmitted the current location registration message to the home agent once, so that it is possible to cope with the case where the improper user uses the mobile computer after the session is established.

Column 13, lines 10-16 reveal that user authentication, as taught, will also address the problem of an improper user who attempts to use the mobile computer after the session is established.

At column 10, lines 15-21, the Inoue ‘519 patent teaches that the registration request and the user authentication information can be bundled in one message or handled as separate messages. Based upon the possibility that the registration request and the user authentication information can be bundled in one message, the Examiner infers (Rebuttal Arguments, page 2) that the number of user authentication failures is the same as the number of registration denials for a mobile computer. This logic is flawed.

Column 14, lines 15-29 (reprinted above) contradict the Examiner’s inference. If (as inferred by the Examiner) the Inoue ‘519 patent considers the number of user authentication failures as being the same as the number of registration denials for a mobile computer, then why would the Inoue ‘519 patent be concerned about the “case where the improper user uses the mobile computer after the session is established,” i.e., a case where repeating the mobile computer’s authentication would lead to a successful registration but repeating the user’s authentication would lead to refusal of registration?

Assuming for the sake of argument that the Sis '925 patent would have been modified according to the Inoue '519 patent, the result would not have the configuration suggested by the Examiner. Rather, the resulting combination (again, *in arguendo*) would adopt processing of the communication address request according to a failure count accessed using the identifier of the user pursuant to the Inoue '519 patent. That is, a distinction over the asserted combination of claim 1 is that the failure count is accessed using the identifier for the mobile station. Again, the Inoue '519 patent teaches using a user identifier for user authentication, e.g., S22 Fig. 12, S32 Fig. 14, S42 Fig. 19, etc., which (as explained above) is considered by the Inoue '519 patent to be different than using a mobile station identifier for mobile station authentication.

Accordingly, claim 1 is patentable over the Examiner's cited references. Each of independent claims 19-20 recites a feature similar to the distinction of claim 1 noted above, and thus at least similarly distinguishes over the applied art. Claims 2-5, 7-11, and 12-17, which directly or indirectly depend upon claims 1 and 19-20, respectively, are also patentable at least for the same reasons.

In the alternative as to dependent claims 7, 8, 14 and 15, the Examiner has acknowledged that each respectively distinguishes over the combination of the Sis '925 patent and the Inoue '519 patent. But the Examiner believes that such distinctions are well known and that it would have been obvious to modify the combination to include the well known features. Appellant traverses that such features were well known and challenges the Examiner to provide evidence of his assertion. Until such evidence is provided, the Examiner has failed to meet his burden of putting forth a *prima facie* case of obviousness.

In view of the foregoing discussion, the rejection is improper.

ADDITIONAL TRAVERSAL REASONING, CLAIMS 6, 11 AND 18

The additional traversal reasoning discussed above informs Appellant's traversal³ of the rejection⁴ of claims 6, 11 and 18. Accordingly, the rejection is improper.

³ See page 7 of the reply by Appellant filed June 12, 2006.

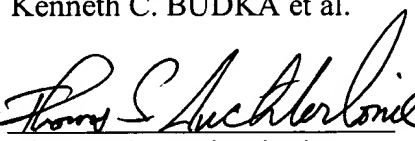
⁴ The statement of rejection is found on page 8 of the Final Office (mailed August 30, 2006).

CONCLUSION

In view of the above remarks, Appellant respectfully requests the Pre-Appeal Brief Conference to find in favor of Appellant's positions and arrange for withdrawal of the above-noted rejections, culminating in the sending of a Notice of Allowance of the pending claims.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,
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By 
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